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APPLICATION NUMBER 08/452,227	FILING DATE 05/24/96	FIRST NAMED APPLICANT JAMES F HANN	ATTORNEY DOCKET NO. 10438-1
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33M1/0410

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EXAMINER CHIA, H

ART UNIT 3302	PAPER NUMBER 9
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DATE MAILED:

04/10/97

NOTICE OF ABANDONMENT

This application is abandoned in view of:

☒ Applicant's failure to timely file a proper response to the Office letter mailed on 8/26/96.

☐ A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of _____ month(s)) which expired on _____.

☒ A proposed response was received on 12/16/96, but it does not constitute a proper response to the final rejection.

(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).

☐ No response has been received.

☐ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.

☐ The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.

☐ The submitted issue fee of \$_____ is insufficient. The issue fee required by 37 CFR 1.18 is \$_____.

☐ The issue fee has not been received.

☐ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.

☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.

☐ The proposed new formal drawings filed _____ are not acceptable.

☐ No proposed new formal drawings have been received.

☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.

☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.

☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ The reason(s) below:

Randy C. Shay
Randy C. Shay
 Primary Examiner

Art Unit:

- ✓ 1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stem fitting within a cavity in the medullary canal must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Claims 1-~~20~~⁷ are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The bioresorbable implant being non-porous, as now claimed in claims 1 and 7, finds no support in the specification as originally filed.
3. Claims 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2173.05(I). The omitted steps are: using a bioresorbable implant to maintain the spacing between the bone surfaces..
- ✓ 4. The only effective method disclosed by applicant in the disclosure of his invention for maintaining the spacing between the bone surfaces is a bioresorbable implant. Applicant's attention is invited to page 5, the first sentence under The Invention in the latest amendment (paper no.4), where Applicant states that "Applicant's invention is directed toward a method of treating a joint using a bioresorbable implant.". No such bioresorbable implant is set forth in claims 21 and 22.

still
new
to new
matter
obj. to spec.

(prior art)

Art Unit:

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-6, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone et al. (5,306,311).

Weight is only being given to claim language which has support in the specification as originally filed.

7. Claims 21-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dow Corning Wright Silastic Trapezial Implant H.P. Brochure.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. (5,306,311) in view of Delcommune et al. (5,007,939).

Stone et al. disclose all steps claimed except for selecting the claimed material for the bioresorbable implant. As taught by Delcommune et al., the claimed material is old and well

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known for use in bioresorbable implants, making selection of this known material for this known purpose obvious to one of ordinary skill in the art.

10. Claims 8-10 and 25 are allowed.

11. Claims 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Applicant's arguments filed August 12, 1996 have been fully considered but they are not persuasive.

✓ Applicant has repeatedly stated in his arguments, which are supported by the originally filed specification, that his invention requires use of a bioresorbable implant in order to function. Therefore, claims 21-22, which require no such resorbable implant are incomplete. Given this, it is not clear why Applicant is resisting inclusion in some claims of this limitation which is critical to the function of Applicant's inventive method.

21/ Applicant's arguments drawn to the implant being "smooth" and "non-porous" are not well taken. First of all, the word "smooth" is not even present in any of the claims. Second of all, neither of these terms finds any support in the specification. No place in the specification, as originally filed, has applicant discussed the implant being either smooth or non-porous, let alone these features being critical. If the smoothness and non-porosity are so critical to the success of the method, as implied in the large paragraph of arguments on page 7 of the latest amendment, then it appears that the specification is defective for not teaching how to make and/or use the

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invention, and the claims are all, similarly, incomplete. Applicant's clarification as to the criticality of the implant being smooth and non-porous are requested, so that the Examiner can determine whether or not these objections and rejections are applicable to the specification and claims, as they now stand.

As stated in the rejection, only subject matter which finds support in the originally filed specification is being given weight.

Applicant's statement that there would be no motivation to use the Stone implant in Applicant's method is not well taken. This argument implies some modification of what is disclosed in Stone. The Examiner is not suggesting taking the Stone implant and using it in another method. This is a 102(b) rejection. All claimed steps are disclosed in the Stone reference.

Arguments with respect to the McDowell reference are well taken and rejections based on this reference have been withdrawn.

It is unclear which claimed method step Applicant is asserting in his arguments that the Dow Corning brochure fails to disclose. What claimed step is not performed in the Dow Corning brochure? Applicant's statement that t"he implant" (presumably Dow Corning's)" is placed in a resected cancellous bone surface to maintain a spacing between the cancellous bone and second joint surface", and that t"his space is not the space between an implant and the cancellous bone surface as in the present embodiment" is not understood. Claim 21 requires "maintaining a spacing between the cancellous surface and another one of the relatively movable surfaces of the

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body joint". Therefore, Applicant's present embodiment seems to require the space to be between two bone surfaces, as disclosed by Dow Corning, and not between the implant and the cancellous bone, as Applicant implies in his arguments. Applicant's main argument against Dow Corning is that their implant doesn't degrade, so it will not work. If that is the case, why won't Applicant put this limitation into claim 21 to make the claim complete. As it stands now, the fact that Dow Corning's implant doesn't degrade is irrelevant because this is not required by the claim language.

Applicant's arguments against using the Delcommune material in place of the Stone material are not well taken. If the material of Delcommune is used, no matrix or scaffold would be required, as no ingrowth would occur or be necessary, just as none occurs or is necessary for the implant of Applicant.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Shay whose telephone number is (703) 308-2907 on Mondays and Thursdays.


Randy C. Shay
Patent Examiner
Art Unit 2800

R. Shay

August 22, 1996